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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/512,593	02/23/2000	John W. Eaton	5050/651	3307

7590 03/26/2007  
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EXAMINER
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JAWORSKI, FRANCIS J

ART UNIT	PAPER NUMBER
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3768

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

09/512,593

**Applicant(s)**

EATON ET AL.

**Examiner**

Jaworski Francis J.

**Art Unit**

3768

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 - 88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                           |                                                                                        |
|-----------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                          | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____                                                |

### **DETAILED ACTION**

The finality of the previous action has been WITHDRAWN.

#### ***Claim Objections***

The claims need amendment with respect to the following:

(a) Amendment in examiner's amendment of 5/30/06 failed to comply with 37 CFR 1.173(c). Pursuant to 37 CFR 1.173(c), each amendment submitted must set forth the status of all patent claims and all added claims as of the date of the submission. (MPEP 1453 (II)). Amendment submitted 4/25/05 failed to include a complete listing of all of the claims with status identifier.

(b) Examiner Amendment of 5/30/06 failed to comply with 37 CFR 1.173((b)(2). All amendments in the reissue application must be made relative to (i.e., vis- à-vis) the patent specification in effect as of the date of the filing of the reissue application. The patent specification includes the claims and drawings. All amendments subsequent to the first amendment must also be made relative to the patent specification in effect as of the date of the filing of the reissue application, and **not** relative to the prior amendment (37 CFR 1.173(g)). Therefore, claims 1, 7 and 20 of the examiner's amendment filed 5/30/06 need to be underlined". Form paragraph 14.21.01 may be used for this 37 CFR 1.173(b) informality.

#### ***Claim Rejections***

Claims 1 – 88 are rejected under 35 U.S.C. 251 for the following reasons:

(1) **Declaration**

The Reissue Declaration filed 2/23/2000 failed to properly identify at least one 35 U.S.C.251 error. It is not sufficient for an oath /declaration to merely state "...New claims 76-79 depend from claim 1 and add subject matter further defining the claimed invention. I believe that I claimed more or less than I had a right to claim. Accordingly, the lack of claims directed to the limitations of these new claims constitutes an error by claiming a different scope of claim coverage than I had a right to claim. The errors cited above for new claims 76-79, including claiming less than I had a right to claim, arose without any deceptive intention on my part". New claims 80-88 were not originally claimed. Independent new claim 80 corresponds to claim 1 with "a second ultrasonic transducer array disposed in the distal end region of the body" deleted; -catheter-- was added before "body having a longitudinal"; and -an absolute sensor disposed in the

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distal end region of the body--was added". These reasons are no longer exist today because claims 77, 80-88 have been cancelled by the examiner amendment.

Rather, the oath /declaration must specifically identify an error. Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error. (MPEP 1414 II. (C)). Therefore, a new reissue declaration in compliance with 37 CFR 1.63 is required to set forth the errors corrected by the examiner's amendment.

The Reissue Declaration must state (a) state that the person making the oath or declaration believes the named inventor to be the original and **first inventor** of the invention claimed as required by 37 CFR 1.63(a)(4); (b) state that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, **as amended by any amendment specifically referred to in the oath or declaration** as required by 37 CFR 1.63(b)(2); and (c) state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to **patentability** as defined in § 1.56 as required by 37 CFR 1.63(b)(3). To cure this defect, applicant may use Form PTO/SB/51 may be downloaded in USPTO Website.

(2) Supplemental Declaration

A supplemental oath/declaration under 37 CFR 1.175(b)(1) is needed to cover errors corrected by examiner amendment of 5/30/06 (add or delete limitations in claims and add or delete claims after filing the Declaration on 2/23/2000). Form paragraph 14.05.02 may be used for this matter. To cure this defect, applicant should use Form PTO/SB/51S maybe downloaded from the USPTO Website. See MPEP \$1444 for handling supplemental oaths/declarations.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Jaworski Francis J. at telephone number 571-272-4738.

FJJ:fjj

03162007



Francis J. Jaworski  
Primary Examiner